



DEC 10 2001

BAKER BOTTS
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112- 4498In re Application of
Paul Phillip VAN SAARLOOS
Application No. 09/719,726
PCT No.: PCT/AU99/00479
Int. Filing Date: 17 June 1999
Priority Date: 17 June 1998
Attorney Docket No. A33827
For: Z AXIS TRACKER

DECISION REFUSING

STATUS

UNDER 37 CFR 1.47

This decision is in response to applicant's petition under 37 CFR 1.47(b), filed 30 July 2001.

BACKGROUND

On 17 June 1999, applicant filed international application PCT/AU99/00479, which claims a priority date of 17 June 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 23 December 1999. A Demand for international preliminary examination, in which the United States was elected, was timely filed on 07 January 2000. Accordingly, the thirty month period for complying with the requirements of 35 U.S.C. 371, expired at midnight on 18 December 2000. (17 December 2000 was a Sunday.)

On 15 December 2000, applicant filed a TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A FILING UNDER 35 U.S.C. 371 accompanied by, *inter alia*, payment of the basic national fee as required by 35 U.S.C. 371(c)(1). No oath or declaration as required under §371(c)(4) accompanied the transmittal.

On 29 January 2001, the United States Designated/Elected Office (PTO) mailed applicant a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 C.F.R. 1.497(a) and (b) and the surcharge for providing the oath or declaration later than thirty months from the priority date were required. Applicant was given a **ONE (1) MONTH** period from the mail date of the Notification to properly respond, with extensions of time obtainable under 37 CFR 1.136(a).

DISCUSSION

On 30 July 2001, rule 47 applicant responded filing a declaration executed by Ian Jeffrey Constable, Director of rule 47 applicant The Lions Eye Institute on behalf of the nonsigning inventor; the instant petition (and fee) under §1.47(b); the surcharge for late filing of the declaration; and a request for extension of time for response within the fifth month (and fee) to make the submission timely¹. Rule 47 applicant asserts that status under §1.47(b) is proper because sole inventor Paul Phillip Van Saarloos refuses to join in the application.

The petition and declaration have been reviewed and found not in compliance with §§1.47(b) and 1.497.

Relevant Rules, Regulations and Procedures

Pursuant to 35 U.S.C. 118, 37 CFR 1.47(b) provides that:

Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

In regards to the required proof of pertinent facts, MPEP 409.03(f) states:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application.

... A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

¹ As 29 July 2001 was a Saturday, a five month extension of time was sufficient to make the submission on 30 July 2001 timely.

MPEP 409.03(d) further states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

...

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

...

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

Analysis

Applicant complied with §1.47(b) by including on petition a statement that the filing under 1.47(b) is necessary to preserve the rights of the parties and to prevent irreparable harm, the petition fee and the last known address of inventor Van Saarloos. However, the petition does not include sufficient proof either of proprietary interest, or that the nonsigning inventor has refused to execute the declaration.

To show sufficient proprietary interest in the invention, rule 47 applicant submitted a copy of an employment agreement dated March 16, 1987, between Dr. Van Saarloos and The Lions Eye Institute of Western Australia Incorporated, and a copy of a service agreement dated 21 May 1999 between Dr. Van Saarloos, TELCO Medical Technologies Pty Ltd. and The Lions Eye Institute of Western Australia Incorporated. However, rule 47 applicant did not include a statement of a person with firsthand knowledge attesting to the invention that is the subject matter of this application having been made by Van Saarloos while he was employed by the 1.47(b) applicant. Rather, rule 47 applicant included a general statement of Ian Jeffrey Constable, upon information and belief, that "pursuant to terms of employment agreements extant between the

inventor, Paul Phillip Van Saarloos, and The Lion Eye Institute at the time the claimed invention was made and at times the applications were filed,” and referencing the above-noted employment and service agreements. The statement is not sufficient. A review of the agreements does not clarify that the subject invention arose out of inventor Saarloos’ employment with rule 47 applicant.

To establish refusal, applicant provides a statement of facts by Director Ian Jeffrey Constable, with supporting exhibits. This statement of facts is not acceptable as it is not made by the person to whom the refusal(s) were purportedly made. In addition, the petition does not include a statement of facts by a person with first hand knowledge and supporting documentary evidence that a bona fide attempt was made to present inventor Van Saarloos with the application papers (specifications, claims, drawings and oath or declaration) prior to the alleged refusal. Mr. Constable’s statement shows only that the declaration and assignment were presented to inventor Van Saarloos for execution. Absent a showing that a *bona fide* attempt was made to present a copy of all of the application papers (specification, claims, drawings and oath or declaration) to inventor Van Saarloos, applicant has not shown that the nonsigning inventor refuses to join in the application. An inventor cannot sign a declaration stating “I have reviewed and understand the contents of the above-identified application,” without first receiving a copy of the application papers.

The deficiencies in this petition under §1.47(a) should be corrected, as follows: Rule 47 applicant should submit a statement of a person with firsthand knowledge attesting to the invention that is the subject matter of this application having been made by Van Saarloos while he was employed by the 1.47(b) applicant, or otherwise establish sufficient proprietary interest. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor continues to be represented by counsel, to the address of the nonsigning inventor’s attorney. Copies of documentary evidence of this presentation, such as certified mail return receipts, cover letter of instructions, should be submitted. The circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Alternatively, if it is concluded by the 37 CFR 1.47 applicant that inventor Van Saarloos’ conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Of course, if inventor Van Saarloos decides to join in the application, a declaration for patent executed by inventor Van Saarloos may be submitted as a proper reply to this dismissal.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any request for reconsideration

should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Commissioner for Patents, Box PCT, Washington, D.C., 20231, with the contents of this letter marked to the attention of the PCT Legal Office.



Nancy Johnson
Petitions Attorney
PCT Legal Office



Leonard Smith
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 305-0309
Facsimile: (703) 308-6459